

### **REMARKS/ARGUMENTS**

Claims 1-63 are pending in the present application. In the Office Action mailed August 25, 2004, the Examiner rejected claims 1, 8-13, 18, 20-22, 29-34, 39, 41-43, 50-55, 60, and 62-63 under 35 U.S.C. § 102. The Examiner also rejected claims 2-7, 14-17, 19, 23-28, 35-38, 40, 44-49, 56-59, and 61 under 35 U.S.C. § 103.

Reconsideration is respectfully requested in view of the above amendments to the claims and the following remarks.

#### **A. Objections to the Drawings**

The drawings and the specification have been amended to address the Examiner's objections to the drawings. Accordingly, Applicants respectfully request that the objections be withdrawn.

#### **B. Objection to the Specification**

The abstract has been amended to address the Examiner's objection to the abstract. Accordingly, Applicants respectfully request that the objection be withdrawn.

#### **C. Rejection of Claims 1, 8-13, 18, 20-22, 29-34, 39, 41-43, 50-55, 60, and 62-63 Under 35 U.S.C. § 102(b)**

The Examiner rejected claims 1, 8-13, 18, 20-22, 29-34, 39, 41-43, 50-55, 60, and 62-63 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,032,195 to Reber *et al.* (hereinafter, "Reber"). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed

it in possession of a person of ordinary skill in the field of the invention.” In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Applicants respectfully submit that claims 1, 8-13, 18, 20-22, 29-34, 39, 41-43, 50-55, 60, and 62-63 are patentably distinct from Reber. Reber does not disclose all of the limitations in these claims.

With respect to claims 1, 22 and 43, Reber does not disclose “receiving object identifier data ... comprising ... formatting characters.” In the Office Action, the Examiner asserts that “Reber teaches ... receiv[ing] object identifier data including ... formatting characters similar to conventional bar code protocol (optical code 14) from an object identifier reader (data reader 30).” Applicants respectfully disagree.

Reber describes the optical code 14 as follows:

The optical code 14 either directly or indirectly encodes navigation data for navigating to the destination 20 via the electronic network 10. For example, the optical code 14 can encode, in accordance with a bar code format, the electronic address for the destination 20. Alternatively, the optical code 14 can provide a code translatable to the electronic address for the destination 20.

Reber, col. 2, lines 58-64 (emphasis added). Thus, Reber does not disclose “receiving object identifier data ... comprising ... formatting characters.” Instead, Reber merely discloses an optical code 14 that “encodes navigation data” such as “the electronic address for the destination 20.” Id.

In addition, claims 1, 22 and 43 recite “identifying the information in the object identifier data.” These claims have been amended to recite that “at least some of the information is not an address on an electronic network.” Support for this amendment may be found in paragraphs 41-42 of Applicants’ specification. Applicants respectfully submit that this amendment further distinguishes claims 1, 22 and 43 from Reber. Reber states:

[I]n response to receiving the message, the network access apparatus 50 performs steps to automatically navigate to the destination 20. If the message directly encodes the electronic address of the destination 20, the network access apparatus 50 decodes the message to determine the electronic address. Thereafter, the network access apparatus 50 links to the destination 20 using

the electronic address.

Reber, col. 5, lines 57-63 (emphasis added). Thus, Reber does not disclose “identifying ... information” that “is not an address on an electronic network.” Instead, Reber merely discloses that “the network access apparatus 50 decodes the message to determine the electronic address.” Id.

Claims 1, 22 and 43 also recite “sending the information to the at least one application.” These claims have been amended to recite that the information is “formatted according to one of a plurality of data formats.” Support for this amendment may be found in paragraph 50 of Applicants’ specification. Applicants respectfully submit that this amendment further distinguishes claims 1, 22 and 43 from Reber. Reber states:

After determining the electronic address, the network access apparatus 50 can perform any combination of: linking to the destination 20, transmitting one or more messages to the destination 20.... By linking to the destination 20, the end user can link to a Web page or an online document, for example. One or more of the messages communicated to the destination 20 may be based upon the task information.

Reber, col. 6, lines 20-29 (emphasis added). Thus, Reber does not disclose “sending ... information” that “is formatted according to one of a plurality of data formats.” Instead, Reber merely discloses “linking to the destination 20” and “transmitting one or more messages to the destination 20.”

In view of the foregoing, Applicants respectfully submit that claims 1, 22, and 43 are patentably distinct from Reber. Accordingly, Applicants respectfully request that the rejection of claim 1, 22 and 43 be withdrawn.

Claims 8-13 depend either directly or indirectly from claim 1, claims 29-34 depend either directly or indirectly from claim 22, and claims 50-55 depend either directly or indirectly from claim 43. Accordingly, Applicants respectfully request that the rejection of claims 8-13, 29-34, and 50-55 be withdrawn for at least the same reasons as those presented above in connection with claims 1, 22, and 43.

With respect to claims 18, 39, and 60, Reber does not disclose “receiving object identifier data ... comprising ... formatting characters.” This difference between Reber and claims 18, 39, and 60 was discussed above.

Claims 18, 39, and 60 recite “identifying the information in the object identifier data.” These claims have been amended to recite that “at least some of the information is not an address on an electronic network.” Support for this amendment may be found in paragraphs 41-42 of Applicants’ specification. Applicants respectfully submit that this amendment further distinguishes claims 18, 39, and 60 from Reber. This difference between Reber and claims 18, 39, and 60 was discussed above.

Reber also does not disclose “receiving object identifier data” that is “formatted according to a first object identifier format” and then “formatting the information according to a second object identifier format.” In the Office Action, the Examiner asserts that “Reber teaches a network navigation device 12 having an optical code 14 and human readable information 16 which is used to identify a destination 20 and a task associated with the destination 20 (see col 2, lines 20-57). Hence, Reber teaches ... formatting the information.” Office Action, page 5. Applicants respectfully disagree.

The portion of Reber cited by the Examiner states, in pertinent part:

A network navigation device 12 having an optical code 14 and human-readable information 16 is used to identify a destination 20 and a task associated with the destination 20. Preferably, the network navigation device 12 comprises a substantially flat substrate which supports the optical code 14 and the human-readable information 16. ... In an exemplary embodiment, the network navigation device 12 comprises a sheet of material supporting the optical code 14 and the human-readable information 16 in a printed form.

The human-readable information 16 is associated with either the destination 20, a means for navigating to the destination 20, or the task associated with the destination 20, to provide an intuitive and/or understandable representation thereof. ...

The destination 20 is provided by a server computer in communication with the electronic network 10. Preferably, the destination 20 is identified by an electronic address using at least a portion of a URL (Uniform Resource Locator), a URN (Uniform Resource Name), an IP (Internet Protocol) address, or an electronic mail address.

Reber, col. 2, lines 20-48. As can be seen from this portion of Reber, Reber does not disclose “receiving object identifier data” that is “formatted according to a first object identifier format” and then “formatting the information according to a second object identifier format.” Instead, Reber merely discloses a “network navigation device 12 having an optical code 14 and human-readable information 16” that is “used to identify a destination 20 and a task associated with the destination 20.” Id.

In view of the foregoing, Applicants respectfully submit that claims 18, 39, and 60 are patentably distinct from Reber. Accordingly, Applicants respectfully request that the rejection of claims 18, 39, and 60 be withdrawn.

With respect to claims 20, 41, and 62, Reber does not disclose “receiving object identifier data ... comprising ... formatting characters.” This difference between Reber and claims 20, 41, and 62 was discussed above.

In addition, claims 20, 41, and 62 recite “identifying the information in the object identifier data.” These claims have been amended to recite that “at least some of the information is not an address on an electronic network.” Support for this amendment may be found in paragraphs 41-42 of Applicants’ specification. Applicants respectfully submit that this amendment further distinguishes claims 20, 41, and 62 from Reber. This difference between Reber and claims 20, 41, and 62 was discussed above.

Claims 20, 41, and 62 also recite “receiving object identifier data ... through a first communication interface” and then “sending the information to the application through the second communication interface.” These claims have been amended to recite that the steps of the method are performed “in a computing device” and that “the application is also running on the computing device.” Support for this amendment may be found in paragraph 37 of Applicants’ specification, and in Figure 1. Applicants respectfully submit that this amendment further distinguishes claims 20, 41, and 62 from Reber. Reber states:

By use of either the optical interface 32 or the input/output interface 52, the data reader 30 transmits a message associated with the optical code 14 to an input/output interface 54 in communication with a network access apparatus

50.

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[T]he network access apparatus 50 can perform any combination of: linking to the destination 20, transmitting one or more messages to the destination 20, and receiving one or more messages from the destination 20.

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The destination 20 is provided by a server computer in communication with the electronic network 10.

Reber, col. 4, lines 25-28; col. 6, lines 20-24; col. 2, lines 43-44. Thus, Reber does not disclose “receiving object identifier data ... through a first communication interface” and then “sending the information to the application on the computing device through the second communication interface.” Instead, Reber merely discloses that “the data reader 30 transmits a message associated with the optical code 14 to ... a network access apparatus 50,” and then the “network access apparatus 50 ... transmit[s] one or more messages to the destination 20.” Id. Even if the destination 20 could be considered to be an “application,” the destination 20 is not “running on” the network access apparatus 50 as required by claims 20, 41, and 62 as amended.

In view of the foregoing, Applicants respectfully submit that claims 20, 41, and 62 are patentably distinct from Reber. Accordingly, Applicants respectfully request that the rejection of claims 20, 41, and 62 be withdrawn.

With respect to claims 21, 42, and 63, Reber does not disclose “receiving object identifier data ... comprising ... formatting characters.” This difference between Reber and claims 21, 42, and 63 was discussed above.

Claims 21, 42, and 63 also recite “identifying the information in the object identifier data.” These claims have been amended to recite that “at least some of the information is not an address on an electronic network.” Support for this amendment may be found in paragraphs 41-42 of Applicants’ specification. Applicants respectfully submit that this amendment further distinguishes claims 21, 42, and 63 from Reber. This difference between Reber and claims 21, 42, and 63 was discussed above.

Reber also does not disclose “sending the information to the plurality of applications.” In the Office Action, the Examiner asserts that “Reber teaches that the identifier information can be sent to a plurality of applications ... (see Figures 1-2, col 2 line 5 to col 7 line 58).” Office Action, page 5. Applicants respectfully disagree.

The portions of Reber cited by the Examiner state, in pertinent part:

[T]he data reader 30 transmits a message associated with the optical code 14 to an input/output interface 54 in communication with a network access apparatus 50.

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In response to receiving the message, the network access apparatus 50 performs steps to retrieve a software agent specific to the destination 20.

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Further in response to receiving the message, the network access apparatus 50 performs steps to automatically navigate to the destination 20. If the message directly encodes the electronic address of the destination 20, the network access apparatus 50 decodes the message to determine the electronic address.

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After determining the electronic address, the network access apparatus 50 can perform any combination of: linking to the destination 20, transmitting one or more messages to the destination 20.... By linking to the destination 20, the end user can link to a Web page or an online document, for example. One or more of the messages communicated to the destination 20 may be based upon the task information.

Reber, col. 4, line 25 – col. 6, line 29 (emphasis added). Thus, Reber does not disclose “sending the information to the plurality of applications.” Instead, Reber merely discloses a network access apparatus 50 that “transmit[s] one or more messages to the destination 20.” Id.

In view of the foregoing, Applicants respectfully submit that claims 21, 42, and 63 are patentably distinct from Reber. Accordingly, Applicants respectfully request that the rejection of claims 21, 42, and 63 be withdrawn.

D. Rejection of Claims 2-7, 14-17, 19, 23-28, 35-38, 40, 44-49, 56-59, and 61 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 2-7, 14-17, 19, 23-28, 35-38, 40, 44-49, 56-59, and 61 under 35 U.S.C. § 103(a) based on Reber in view of U.S. Publication No. 2003/0088643 to Shupps et al. (hereinafter, "Shupps"). This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142. In addition, in order to rely on a reference as a basis for rejection under 35 U.S.C. § 103(a), "the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP § 2141.01(a) (quoting In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)).

The Shupps reference is nonanalogous art, and therefore may not be used to establish a rejection of the claims under 35 U.S.C. § 103(a). The Shupps reference is not within Applicants' field of endeavor. Applicants' field of endeavor is machine-readable object identifiers, such as bar codes, matrix codes, radio-frequency identification (RFID) tags, magnetic stripes, smart cards, punch cards, etc. In contrast, the Shupps reference "relates in general to isolating and interrelating components of an application, and more particularly, to identifying the components of a web-enabled



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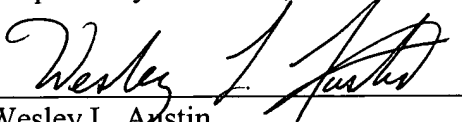
(*e.g.*, internet) application, collecting data regarding the components and establishing relationships between the components.” Shupps, paragraph 2.

In addition, the Shupps reference is not reasonably pertinent to the problem with which the Applicants were concerned. “A reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). A person having ordinary skill in the art would not reasonably have expected to solve a problem related to machine-readable object identifiers by considering a reference related to “isolating and interrelating ... the components of a web-enabled (*e.g.*, internet) application.” Shupps, paragraph 2.

E. Conclusion

Applicants respectfully assert that claims 1-63 are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

  
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**Amendments to the Drawings:**

The attached sheets of drawings includes changes to Figures 13 and 14. These sheets replace the original sheets including Figures 13 and 14.

Attachment: Replacement Sheets